REMARKS

Applicants acknowledge receipt of an Office Action dated April 2, 2002. In this response, Applicants have amended claims 1, 3 and 15 and added claims 21-25. Support for these amendments may be found in the specification *inter alia* at page 4, lines 7-10, page 5 , lines 1-3 and page 5, lines 21-29. Following entry of these amendments, claims 1-25 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Specification

On page 2 of the Office Action, the PTO has noted that the incorporation of essential material in the specification by reference to a foreign application, patent or publication is improper. Applicants will amend the disclosure to incorporate essential material from German Patent Application No. 199 52 898.5, the priority document for the present application, if such amendments become necessary during the course of prosecution.

Rejections Under 35 U.S.C. §102

Also on page 2 of the Office Action, the PTO has rejected claims 1, 2, 3, 15 and 19 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent 5,508,689 to Rado *et al.* (hereafter "Rado"). In this response, Applicants have amended claims 1 and 15. In view of this amendment and for the reasons set forth below, Applicants respectfully traverse this rejection.

As amended, claims 1 and 15 each specify that "the electrical circuit comprises programmable memory suitable for overwritably storing a subscriber number."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131. Here, Rado fails to disclose that "the electrical circuit comprises programmable memory suitable for overwritably storing a subscriber number"

as recited in amended claims 1 and 15. The PTO has acknowledged these deficiencies in paragraph 9 on page 3 of the Office Action. Accordingly, Rado cannot properly anticipate claim 1 or the claims depending therefrom within the meaning of §102.

Since claims 2-3 and 19 depend from claim 1 and necessarily include all of the elements of claim 1, these claims are believed to be allowable for at least the same reasons as claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 1-3, 15 and 19 under §102.

Claim Rejection Under 35 U.S.C. §103

On page 3 of the Office Action, the PTO has rejected claims 4-14, 16-18 and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Rado in view of U.S. Patent 5,841,360 to Binder (hereafter "Binder"). For the reasons set forth below, Applicants respectfully traverse this rejection.

As discussed *supra*, claims 1 and 15 each specify that "the electrical circuit comprises programmable memory suitable for overwritably storing a subscriber number." On page 3 of the the Office Action, the PTO has acknowledged that Rado fails to disclose memory for overwritably storing a subscriber number.

In an attempt to resolve theses deficiencies, the PTO has combined Rado with Binder and relying on Binder's disclosure of PSIC's (line-Powered, Serially connected Intelligent Cells). The PTO specifically cites lines 4-7, lines 10-13 and lines 37-48 of column 7 in Binder.

If the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further, as set forth in MPEP §2143.01, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Finally, according to MPEP §2143.02, the prior art can be modified or combined to

reject claims as *prima facie* obvious only if there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)."

Here, the proposed modification would (1) change Rado's principle of operation and thereby (2) render Rado unsuitable for its intended purpose. In addition, the PTO (3) has failed to establish a reasonable expectation of success.

At column 2, lines 31-43, Rado states that:

> [T]he hostile operating environment of a typical vehicle poses a number of problems in developing a reliable high-speed communication system. For such applications, a communication system must have sufficient reliability and bandwidth (or bit rate) to accommodate real-time control of systems which are essential to operator safety. The system must also be sufficiently immune to electromagnetic interference (EMI or noise) generated by the operation of various switches, motors and other electronic circuits. As is known, this typically requires some physical separation between power distribution lines and control signal delivery lines.

At column 3, lines 55-57 Rado discuses the use of *separate* power distribution and communication trunks, and, in the paragraph bridging columns 3 and 4, Rado discusses the use of distinct power and communication lines.

As stated *supra*, Binder's PSIC's are line-Powered, Serially connected Intelligent Cells. These PSIC's are used in "systems which provide for simultaneous distribution of power and message information along the same wires." See column 1, lines 6-7. Further, the PSIC's are used to de-couple the power from the data signal. See, for example, column 5, lines 10-12.

In view of Rado's disclosure that power distribution lines "typically require some physical separation" and Rado's disclosure of the use of separate power and communication lines, Applicants submit that one skilled in the art would not be

motivated to combine Binder, a reference which discloses the transmission of data *over* power lines, with Rado. Applicants submit that a person having ordinary skill in the art would readily recognize that simultaneous distribution of power and data along the same wires would be unsuitable in vehicle applications, because power fluctuations likely would interfere with data signals such as those for critical systems, i.e., the anti-lock braking system.

Modifying Rado to incorporate the PSIC's of Binder as proposed by the PTO would *change the principle of operation* of Rado because, in contrast to the circuits of Rado, the PSIC's are designed for use with systems in which power and data are transmitted over the same wires and because the PSIC's are designed to de-couple power and data signals. This change in the principle of operation would render Rado *unsuitable for its intended use* in vehicles. Further, there would be *no reasonable expectation of success* based on the proposed combination because the PSIC's of Binder do not appear to be compatible with Rado's control system.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that the claims which depend directly or indirectly from claims 1 and 15 are nonobvious for the same reasons as claims 1 and 15.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under §103.

Newly Added Claims

In this response, Applicants have added claims 21-25. Independent claim 21 specifies that "the electrical circuit includes a programmable memory which comprises an EEPROM" and recites that the apparatus comprises "two mutually associated connector parts for connecting the circuit to the cable wherein each connector part comprises at least 2 planes, each plane comprising at least 3 connector contacts that are selectively connectable to a conductor in the cable". Neither Rado nor Binder, taken individually or in fair combination, teach or properly suggest either an EEPROM or the presently claimed connector parts.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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MARKED UP VERSION SHOWING CHANGES MADE

Below are the marked up amended claim(s):

1. (Amended) An apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle, comprising:

an actuating drive;

an electrical circuit operatively connected to the actuating drive wherein the electrical circuit comprises programmable memory suitable for overwritably storing a subscriber number;

a control section for inputting control commands to the electrical circuit; and

at least one electrical cable connecting together the actuating drive, the circuit and the control section, wherein the circuit is arranged remote from the actuating drive and from the control section.

3. (Amended) An apparatus as claimed in claim 1, wherein the cable comprises a databus[, and the circuit includes a programmable memory].

15. (Amended) A method for installing an apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle, comprising:

installing an actuating drive for a control element;

installing a control section for inputting control commands to the control element;

installing an electrical circuit operatively connected to the actuating drive but at a position remote from both the actuating drive and the control section, the electrical circuit [including a] comprises programmable memory suitable for overwritably storing a subscriber number associated with the control element;

connecting together the actuating drive, the circuit and the control section with at least one electrical cable comprising a databus; and

storing in the memory a first subscriber number not later than in conjunction with the installation.